

Remarks

1. Claim Rejections - 35 U.S.C. §102

Applicant requests reconsideration of the rejection of claim 1 under 35 U.S.C. 102(b) as being anticipated by the international reference to Techboot WO 92/14372 (WO '372).

Claim 1 includes a boot having a layer of compressible cold insulating material which is secured to the inside of an oversized toe box in its uncompressed state. It is noted at the outset that there is no suggestion in WO '372 that the toe box is oversized.

The Examiner contends that the non-flammable ester foam lining 43 of WO '372 is shown in the patent in its uncompressed state. Applicant has argued that, to the contrary, in Figures 2 and 4 of WO '372 the section of foam lining 43 under the toe cap 27 is shown in a compressed state. In response to that argument, the Examiner asserts that merely because the foam lining 43 is not as thick as it is elsewhere does not mean that in Figures 2 and 4 it is in a compressed state, and further the Examiner maintains that if foam lining 43 was in a compressed state, it would bulge into the foot cavity as there is nothing there to hold it and prevent it from doing so.

It is respectfully submitted that the Examiner's assertion that the foam lining 43 shown in FIG. 2 and 4 is not of uniform thickness is incorrect. The thickness of the foam lining shown in Figures 2 and 4 is presumably the same thickness as the foam lining shown in Figure 3. That is so because nothing in the WO '372 specification suggests that the thickness of the foam lining is different in the different figures. (See, for example, the description of the foam lining at page 11, lines 10 to 14, merely noting that the "fire-fighting boot of figure 2 also includes a non-flammable ester foam lining 43.") The foam lining shown in FIG. 3 is of uniform thickness and

therefore, contrary to the Examiner's assertion, the foam lining shown in FIG. 2 and FIG. 4 is presumably also of uniform thickness. If that is so, the portion of foam lining 43 below the toe cap in FIG. 2 and FIG. 4 would be compressed. Further, as to the Examiner's contention that if the foam lining 43 was in a compressed state it would bulge into the foot cavity, it is submitted that the soft leather lining sock 41 would prevent the compressed foam lining 43 from bulging into the foot cavity.

2. Claim Rejections - 35 U.S.C. §103

a. Applicant requests reconsideration of the rejection of claims 1, 5 and 6 under 35 U.S.C. 103(a) as being unpatentable over WO '372 in view of Official Notice. The Examiner contends that Official Notice should be taken that it would be obvious to one of ordinary skill in the art, at the time the invention was made, to make the insulating material any thickness to insulate the boot to hold the desired temperature. Applicant submits that even assuming arguendo it would be obvious to make the insulating material any thickness, nevertheless, because WO '372 does not disclose an oversized toe box, and because lining 43 of WO '372 is compressed, the proposed modification to WO '372 would not render claims 1, 5 and 6 unpatentable.

b. Applicant requests reconsideration of the rejection of claims 1, 5 and 6 as being unpatentable over White 3,805,419 or Adams 4,102,062 in view of WO '372.

(i) White

Applicant's invention is directed to a boot in which an outer layer of leather is stretched over the toe area of the boot during the manufacturing process. To prevent compression of the

cold insulating material by the stretching of the leather during the manufacturing process, an oversized toe box is provided so that the insulating material may be secured to the inside of the toe box.

The manufacturing process of the White footwear is distinctly different. White utilizes an essentially finished footwear in which a completely pre-assembled toe cap is inserted into the toe region of the finished footwear. See, for example, col. 5, lines 13-17.

“It is believed that the present invention is the first that accomplishes insertion of a complete toe cap and lining assembly into an essentially finished footwear article of any type such as for example a molded footwear article or a machine-made shoe ...”

Claim 1 of the present application recites that the outer layer of leather is manually or mechanically stretched over the oversized toe box. No such stretching occurs in the White footwear. Thus, even assuming arguendo that it would have been obvious to provide White with an outer layer of leather, the leather would not have been manually or mechanically stretched over an oversized toe box.

The Examiner contends that the toe box of White is oversized because when placed in a shoe sized for a size 12 foot the toe box would be oversized for a size 9 foot. There is, however, no reason why anyone would place a toe box sized for a size 12 foot in a size 9 shoe (assuming that a toe box sized for a size 12 foot would fit in a size 9 shoe).

The Examiner also contends that the outer layer **8** of White is, in fact, stretched over the toe cap because the outer layer had to be pulled over the White toe cap. But, the White outer layer is not pulled over the toe cap at all, rather, the White toe cap is inserted into the outer layer without any apparent stretching of the White outer layer.

Finally, the Examiner contends that it would have been obvious to make the outer layer

of White out of leather to protect the user's foot as well as other elements of the shoe from scraping. But, there is no reason to believe that the molded polyvinyl chloride outer layer of White would not be fully adequate to protect the White footwear against scraping. Further, the polyvinyl chloride outer layer has particular utility in his process (see, for example, col. 4, lines 40-49), and to substitute leather for the polyvinyl chloride would presumably interfere with that process.

(ii) Adams

In Adams, there is no indication that toe box **12** shown in FIGS. 1 and 3 is oversized. The drawings of Adams disclose a toe box which appears to be of conventional size and, in fact, Adams recites that metal toe protector **12** is of the type that is fairly conventional (see, col. 1, lines 64-68).

Further, there would not have been any motivation to make the Adams boot of leather, as proposed by the Examiner, to aid in protecting the user's foot from impacts. There would not have been any such motivation to so modify Adams because the wearer's foot is already fully protected from very heavy impact loads as a result of metatarsal guard **13** and toe protector element **12**. As Adams recites at column 3, lines 19-30:

“Referring again to FIG. 2, should a heavy weight fall from above on the foot portion of the boot, the impact force will be mainly applied to the central section **28** of guard **13** and transmitted down the sides to be distributed and absorbed at the sole. Under severe impact which might temporarily slightly deform the central section **28** the force is either not passed on to the wearer's foot or is cushioned by layer **23**. The guard **13**, even under very heavy impact loads, will strongly resist any change in its shape or position, and the sides **27** and **28** will not tend to spread outwardly under impact or crushing so that the wearer's foot is fully protected.”

Thus, the substitution of a leather outer layer in Adams would not have added any impact protection to the already fully protected Adams boot and there would not have been any motivation to form the Adams boot of leather.

The Examiner contends that the same reasoning for the “oversized” toe box rejection applied to White also applies to Adams. Applicant’s above-noted comments as to why the White toe box is not oversized also apply to why the Adams toe box is not oversized.

The Examiner further contends, as with the White reference, that it would have been obvious to make the outer layer of Adams of leather to protect the user’s foot as well as other elements of the shoe from scraping. Here, again, there is no reason to believe that the rubber outer layer of Adams would not be fully adequate to protect against scraping. Certainly, the Adams boot which is designed to withstand the impact of a heavy weight should be able to adequately withstand scraping of the shoe.

Conclusion

In view of the foregoing, it is respectfully submitted that claims 1, 5 and 6 are patentable over the cited prior art, either singly or in combination.

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Respectfully submitted,



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